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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO
10/078,005	02/20/2002	Stan Wojciak	LC-301/PCT/US/CON	4721
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LOCTITE CORPORATION			EXAMINER	
1001 Trout Broo Rocky Hill, CT		BERMAN, SUSAN W		SUSAN W
			ART UNIT	PAPER NUMBER
			1711	
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Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
•	10/078,005	WOJCIAK ET AL.
Office Action Summary	Examiner	Art Unit
	Susan W Berman	1711
The MAILING DATE of this communication app Period for Reply	pears on the cover sheet with the o	correspondence address
A SHORTENED STATUTORY PERIOD FOR REPL	Y IS SET TO EXPIRE 3 MONTH	(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.  - Extensions of time may be available under the provisions of 37 CFR 1.1 after SIX (6) MONTHS from the mailing date of this communication.  - If the period for reply specified above is less than thirty (30) days, a rep If 1/O period for reply is specified above, the maximum statutory period Failure to reply within the set or extended period for reply will by statute Any reply received by the Office later than three months after the mailin earned patent term adjustment. See 37 CFR 1.704(b)	136(a) In no event, however, may a reply be till it within the statutory minimum of thirty (30) day will apply and will expire SIX (6) MONTHS from a cause the application to become ABANDONE	mely filed //s will be considered timely if the mailing date of this communication ED (35 U S C § 133)
Status		
1) Responsive to communication(s) filed on 20		
,	nis action is non-final.	
3) Since this application is in condition for allow closed in accordance with the practice under Disposition of Claims		
4) Claim(s) 1,4-14 and 16-36 is/are pending in the	ne annlication	
4a) Of the above claim(s) is/are withdra	• •	
5) Claim(s) is/are allowed.		
6) Claim(s) <u>1,4-14,16-36</u> is/are rejected.		
7) Claim(s) is/are objected to.		
8) Claim(s) are subject to restriction and/o	or election requirement.	
Application Papers		
9)☐ The specification is objected to by the Examine	er.	
10) The drawing(s) filed on is/are: a) acce		
Applicant may not request that any objection to the		
11) The proposed drawing correction filed on		oved by the Examiner.
If approved, corrected drawings are required in re	• •	
12) The oath or declaration is objected to by the Ex	kaminer.	
Priority under 35 U.S.C. §§ 119 and 120	051100004400	- \ (.1) (6)
13) Acknowledgment is made of a claim for foreig	n priority under 35 U.S.C. § 119(a	a)-(d) or (t)
a) All b) Some * c) None of:	to have been received	
<ul><li>1. Certified copies of the priority document</li><li>2. Certified copies of the priority document</li></ul>		ion No
Copies of the certified copies of the prior		
application from the International Bu * See the attached detailed Office action for a list	ureau (PCT Rule 17.2(a)).	
14) Acknowledgment is made of a claim for domest	ic priority under 35 U.S.C. § 119(	e) (to a provisional application).
a) ☐ The translation of the foreign language pro 15)☐ Acknowledgment is made of a claim for domes		
Attachment(s)		
1) Notice of References Cited (PTO-892) 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s)	5) Notice of Informal	y (PTO-413) Paper No(s) Patent Application (PTO-152)
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## Priority

The specification has been amended to contain a specific reference to the prior application(s) in the first sentence of the specification to the earlier applications for which the benefit of an earlier filing date is sought. The prior applications are identified in the Oath submitted 02-20-2002. Thus, Applicant has complied with the conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120.

## Response to Arguments

The objection to the amendment filed 02-20-2002 under 35 U.S.C. 132 because it introduces new matter into the disclosure is hereby withdrawn. Applicant points out that the added material is disclosed by incorporation by reference to US Patent 5.328.944. See page 12, lines 23-36, and US 6.433.036, column 7, lines 40-52.

The rejection of claims under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for compositions comprising metallocenes of structure I or structure II, shown on pages 6-9, in combination with one or more of the photoinitiators disclosed on page 10, does not reasonably provide enablement for any known metallocene substance and any known photoinitiator is withdrawn in response to applicant's arguments. Other kinds of metallocenes are disclosed on page 9, lines 18-27. Numerous kinds of photoinitiator are disclosed on pages 9-10.

With respect to applicant's arguments with regard to claims 6, 7, 9, 11 and 12 that the current rejection is inconsistent with the prosecution of the prior patents, the inconsistency is no reason to perpetuate the original errors.

The rejection of claim 20 under 35 U.S.C. 101 as claiming the same invention as that of claim 4 of prior U.S. Patent No. 5,922,783 is withdrawn in view of the withdrawal of the new matter rejection set forth in paper number 4.

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Applicant argues that there is no disclosure, teaching or suggestion to combine the teachings of Mikune et al and Attarwala et al. This argument is not persuasive because each reference discloses adhesive compositions comprising alpha-eyanoacrylate as the major component. Furthermore, Mikune et al teach adding heat stabilizers, though it is agreed that no specific kinds of heat stabilizers are mentioned. One of ordinary skill in the art at the time of the invention would have been motivated to employ the heat stabilizers taught by Attarwala et al for alpha-cyanoacrylate adhesive compositions to enhance thermal resistance, as taught by Attarwala et al, and by a reasonable expectation of providing cured products stabilized to avoid thermal instability. Applicant alleges that a photocurable eyanoacrylate system is a more sensitive system than the conventional cyanoacrylate composition and that additives may have adverse effects on stability. This argument is not persuasive for three reasons. First, no evidence has been presented to support the allegations made. Second, the argument that additives may have adverse effects on stability suggests the advisability of adding heat stabilizers. Third, Mikune et al clearly teach that heat stabilizers may be added to the disclosed photocurable compositions comprising metallocene and cleavage-type photoinitiators. Therefore, the rejections of record under 35 103(a) are maintained.

Applicant argues that evidence of unexpected results with respect to shelf stability has been obtained in experiments conducted as set forth on pages 23-25 of paper number 5 filed 09-20-2002. The experiments noted are not included in the instant specification or presented in the form of an Affidavit under 37 CFR 1.132.and, therefore, has no probative value.

Applicant argues that the acrylate and epoxy chemistry disclosed by Gatechair et al is significantly different from the cyanaoacrylate chemistry disclosed by Mikune et al or Attarwala et al and, therefore, the teachings of Gatechair et al cannot be combined with the teachings of Mikune et al or Attarwala et al. This argument is not found persuasive because Gatechair et al is relied upon for teaching species of cleavage photointiators that can be employed with metallocenes to provide photocurability for

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monomers that polymerize by free radical mechanisms. Cyanoacrylate monomers are known to be polymerizable by anionic and or free radical mechanisms. See Coover et al. of record.

Applicant argues that Coover et al do not teach or suggest curing cyanoacrylates thorugh exposure to radiation or the addition of a particular sulfur compound to achieve any desired effect. This argument is not found persuasive for the following reasons. It is agreed that Coover et al do not mention curing cyanoacrylate compositions by exposure to radiation. However, Coover et al discuss both anionic polymerization and free radical polymerization of cyanoacrylates. It is known in the photopolymerization art the metallocenes such as those instantly disclosed initiate anionic polymerization and that cleavage photoinitiators such as those instantly disclosed initiate free radical polymerization upon activation by exposure to radiation. Therefore, it is the examiner's position that one of ordinary skill in the art at the time of the invention would have recognized that the teachings of Coover et al and Mikune et al are analogous art in the same field of endeavor. Furthermore, Coover et al discuss stabilizers and inhibitors for cyanoacrylate compositions and specifically mention adding organic sulfur compounds, including alkyl sulfates, sulfones, sulfoxides, sulfites and 3-sulfolene, such as those taught by Attarawala et al.

#### Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 24 and 25 are rejected under 35 U.S.C. 112. first paragraph, because the specification, while being enabling for polymerizing a composition according to claim 1 by exposure to electromagentic radiation, does not reasonably provide enablement for "polymerizing" the compositions by other means.

The specification does not enable any person skilled in the art to which it pertains, or with which it is

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most nearly connected, to practice the invention commensurate in scope with these claims. See page 5, lines 11-37.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5, 6, 7, 9, 11, 12, 16, 23, 26 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 5, line 2: there is no antecedent basis for "cyanoacrylate monomer" in claim 1, which recites "2-cyanoacrylate". Claims 6, 7, 9, 11: the claims are rendered indefinite by the phrases "may occur", "may be", "may or may not be". It is not clear whether the substituents being defined are as recited or not. Claim 12: it is not clear what kinds of "derivatives" of ferrocenes or titanocenes are suitable. The kinds of derivatives suitable in the instant invention should be clearly set forth.

Claim 23: it is not clear how the article is "assembled" with the "composition of claim 1". In order to obtain an article, the composition should be cured by exposure to electromagnetic radiation to provide an adhesive, as set forth in claim 24.

Claim 26 provides for the use of the one-part "composition" according to claim 19, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced. There is nothing in the claim language that distinguishes the intended method of assembly from the "assembly...by applying onto a substrate a primer, followed by an adhesive composition". There is no antecedent basis for "one-part composition" in claim 19, which recites a "one-part formulation".

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Claim 30 recites a "composition according to claim 26" that lacks antecedent basis in claim 26, which recites a "method...".

Claim 16, submitted in Preliminary Amendment A filed 02-20-2002, has not been entered because the claim contains brackets. The brackets render the claim indefinite because it is not clear whether applicant intends to recite "thermal-stabilizing agents" or to delete the phrase from the claim.

## Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 26 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

#### Claim Rejections - 35 USC § 102/103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 4-7, 11-14, 16-22, 26-34 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mikune et al (US 5.824,180 or EP 0 769 721 A1) in view of Attarwala et al (5,328,944).

Mikuni et al disclose adhesive compositions comprising an alpha-cyanoacrylate and a metallocene or a mixed catalyst comprising a metallocene and a cleavage-type photoinitiator. The mixed

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catalyst can be a metallocene and an acylphosphine oxide photoinitiator. APO is used with ferrocene in Example 5 of US \*180. Irgacure 184 is used with ferrocene in Example 6 of US \*180. APO is used with ferrocene in Examples 6, 15, 23, 28, 34, 39, 44, 50 and 72-101 of EP \*721. Addition of heat stabilizers is taught (column 7, line 35 of US \*180 or page 10, line 59, of EP \*721). With respect to claims 6, 7, 11, 12 and 13, Mikune et al disclose metallocenes encompassed by those instantly claimed. With respect to claim 14, several of the recited photoinitiators are disclosed by Mikuni et al. With respect to claim 16, it is noted that Mikune et al teach that the cyanoacrylate compositions "may, if necessary, contain one or more additives such as ... thickening agents....fillers...". See page 10.

Attarawala et al teach that it is known to employ sulfur containing compounds corresponding to those set forth in the instant specification in cyanoacrylate adhesive compositions in order to enhance the thermal resistance of the cured polymer.

It would have been obvious to one skilled in the art to employ a metallocene catalyst further comprising cleavage-type photoinitiator as taught by Mikune et al. Mikune et al teach that the photocurability can be greatly improved by incorporating a cleavage-type photoinitiator into the composition (Abstract of EP '721). In US '180, Mikune et al teach that the mixture of metallocene and cleavage photoinitiator provides equivalent photocurability and curing time to a metallocene used alone. It would have been obvious to one skilled in the art to include a sulfur-containing compound to enhance thermal resistance, as taught by Attarwala et al, as the heat stabilizer in the compositions disclosed by EP '721. One of ordinary skill in the art at the time of the invention would have been motivated to do so by the teaching of Attarwala et al that sulfur-containing compounds enhance the thermal resistance of cured cyanoacrylate adhesives. US '180 or EP '721 each provides motivation by teaching addition of heat stabilizers to the disclosed cyanoacrylate adhesive compositions. Thus, one of ordinary skill in the art at the time of the invention would have been motivated to employ the heat stabilizers taught by Attarwala et

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al for alpha-cyanoacrylate adhesive compositions by a reasonable expectation of providing cured products stabilized to avoid thermal instability.

With respect to claims 20-21. It would have been obvious to one skilled in the art at the time of the invention to employ a mixture of Irgacure 184 and an acylphosphine oxide as the cleavage-type photoinitiator in the compositions disclosed by Mikuni et al because Mikuni et al teach that the phenylpropanone and acylphosphine oxide photoinitiators are equivalent for use as cleavage-type photoinitiators and also teach that the photoinitiators can be used alone or in mixtures (page 10, lines 19-43). It would further have been obvious to one skilled in the art at the time of the invention to determine the optimum amounts of cyanoacrylate, ferrocene and photoinitiator required to obtain the desired cure from the teachings of Mikune et al. in the absence fo evidence to the contrary.

With respect to claims 27-29 and 36: Applicant states in the instant specification, on page 11. line 11, to page 12, line 3, that "ordinarily eyanoacrylate compositions free of added thickener or viscosity modifier are low viscosity formulations (such as in the range from 1 to 3 cps)". Also see Hiraiwa 4,818,325 for a teaching of the low viscosity of 2-cyanoacrylate compositions. It is the examiner's position that the compositions disclosed by Mikune et al would inherently be low viscosity formulations having viscosities within the recited ranges in the claims because the cyanoacrylate compositions appear to be free of thickener or viscosity modifier. Alternatively, especially with respect to the viscosity of 1-15 cps in claim 27 or claim 36 or the viscosity of 1-3 cps in claim 36, it would have been obvious to one skilled in the art at the time of the invention to omit any thickeners or fillers from the compositions taught by Mikune et al. Mikune et al provide motivation by teaching that such additives can be used "if necessary" to heighten the viscosity of the composition. One skilled in the art at the time of the invention would have been motivated by an expectation of providing low viscosity formulations in the absence of thickening agents or fillers. There is no evidence of record showing unexpected results obtained by limiting the viscosity as set forth in the instant claims. With respect to the viscosity from 100-300 cps in

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claim 28 or claim 36 or the viscosity from 600-1000 eps in claim 29 or claim 36: It would have been obvious to one skilled in the art at the time of the invention to add thickening agents or fillers that function as thickening agents to the cyanoacrylate compositions taught by Mikune et al in order to heighten the viscosity of the compositions. Mikune et al provide motivation by teaching that thickening agents can be added to heighten the viscosity of the composition. It would have been obvious to one skilled in the art at the time of the invention to determine the optimum viscosity of a cyanoacrylate composition taught by Mikune et al required for a particular bonding application. Cyanaoacrylate compositions for bonding applications are well known in the art and determination of the viscosity required for bonding applications is considered to be within the skill of one having ordinary skill in the relevant art.

Claims 1, 4-7, 11-14, 16-22, 26-34 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mikune et al (EP '721) in view of Attarwala et al, as applied to claims 1, 4-7, 11-14, 16-22, 26-34 and 36 above, and further in view of Gatechair et al (4,707,432). The disclosures of Mikune et al and Attarwala et al are discussed above.

Gatechair et al teach the use of a photoinitiator and a ferrocenium salt in a free radical polymerizable compositions. The photoinitiators disclosed include acetophenones, ketals, aryl glyoxalates, acylphosphine oxides and aromatic halonium salts, including several photoinitiators recited in instant claim 14. Esters of (meth)acrylic acid are taught as suitable free radically polymerizable materials. Cationically polymerizable materials are also taught. Irradiation with light from 200 to 600 nm is taught. Gatechair et al teach that the blend of photoinitiators improves light sensitivity of compositions where greater sensitivity to visible light is required.

It would have been obvious to one skilled in the art at the time of the invention to employ the cleavage photoinitiators taught by Gatechair et al as being useful in combination with a ferrocene

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component as the cleavage photoinitiator in the compositions disclosed by Mikune et al in combination with Attarwala et al. as set forth above. Mikune et al teach adding a cleavage-type photoinitiator to a metallocene to improve the photocurability of the cyanoacrylate composition. Gatechair et al provide motivation to substitute the disclosed cleavage photoinitiators for those specifically taught by Mikune et al by teaching that they are equivalent in function when used with ferrocene, a well-known metallocene. It would have been obvious to one skilled in the art to select a photoinitiator having sensitivity to visible light from those taught by Gatechair et al because Gatechair et al teach that the combination of free radical curing agents and ferrocenium salts provides increased sensitivity to visible light and a significant improvement in cure (column 1, lines 38-51).

Claims 23-26 and 30-32 are rejected under 35 U.S.C. 103(a) as obvious over Mikune et al in view of Attarwala et al, as applied to claims 1, 4-7, 11-14, 16-22, 26-34 and 36 above, and further in view of H.W. Coover et al "Cyanoacrylate Adhesives". The disclosures of Mikune et al and Attarwala et al are discussed above.

Coover et al teach that cyanoacrylate adhesives are useful for bonding electronic components and medical and dental devices, among other uses. It would have been obvious to one skilled in the art at the time of the invention to employ compositions comprising cyanoacrylate monomers selected from those disclosed by Mikune et al in combination with Attarwala et al for the uses discussed by Coover et al.

### Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*. 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 4-14 and 16-36 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9, 11-14, 16-34 of copending Application No. 10/094816 in view of Attarwala et al '944. The claims of Serial No. 10/094816 recite compositions comprising the same components as set forth in the instant claims except for the sulfur compound. Attarwala et al teach that it is known to employ sulfur containing compounds in cyanoacrylate adhesive composition in order to enhance the thermal resistance of the cured polymer. It would have been obvious to one skilled in the art to include a sulfur-containing compound, as taught by Attarwala et al, in the compositions claimed in SN '816. One of ordinary skill in the art at the time of the invention would have been motivated to do so by the teaching of Attarwala et al that sulfur-containing compounds enhance the thermal resistance of cured cyanoacrylate adhesives.

This is a <u>provisional</u> obviousness-type double patenting rejection.

Claims 1, 4-14, 16-22 and 26-36 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 5 922 783 in view of Attarwala et al. Although the conflicting claims are not identical, they are not patentably distinct from each other for the following reasons. The claims of US '783 recite compositions comprising an alphacyanoacrylate, a metallocene and a photoinitiator. Attarwala et al teach that it is known to employ sulfur containing compounds in cyanoacrylate adhesive composition in order to enhance the thermal resistance of the cured polymer. It would have been obvious to one skilled in the art to include a sulfur-containing compound, as taught by Attarwala et al, in the compositions claimed in SN '816. One of ordinary skill in

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the art at the time of the invention would have been motivated to do so by the teaching of Attarwala et al that sulfur-containing compounds enhance the thermal resistance of cured cyanoacrylate adhesives. The viscosities recited in instant claims 27-29 and 36 are considered to be inherent properties of the compositions claimed in US '783. Compositions encompassed by the comprising language of the claims would be expected to provide different viscosities varying from very low viscosities when only eayanoacrylate monomers are present to higher viscosities when thickening agents or viscosity modifiers are present. Addition of thickening agents or viscosity modifiers is taught in column 5 of US '783.

Claims 1, 4-14, 16-22 and 26-346are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 5 922 783 and Attarwala et al and further in view of Mikune et al. Although the conflicting claims are not identical. they are not patentably distinct from each other for the following reasons. The scope of the claims overlaps since the 2-cyanoacrylate component, the metallocene component and the photoinitiator component are the same. See the rejection over US '783 and Attarwala et al set forth above. The claims of US '783 do not recite viscosities or mention thickening agents or viscosity modifiers; however, the comprising language of the claimed compositions encompasses such additives. Addition of thickening agents or viscosity modifiers is taught in column 5 of US '783. Mikune et al teach adding thickening agents or fillers to heighten the viscosity of analogous cyanoacrylate compositions. Therefore, It would have been obvious to one skilled in the art at the time of the invention to add thickening agents to the composition disclosed by US '783 provide heightened viscosity, as taught by Mikune et al in analogous compositions.

Claims 23-26 and 30-32 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 5 922 783 in view of

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Attarwala et al and further in view of H.W. Coover et al "Cyanoacrylate Adhesives". See the rejection

over US '783 and Attarwala et al set forth above. Coover et al teach that cyanoacrylate adhesives are

useful for bonding electronic components and medical and dental devices, among other uses. It would

have been obvious to one skilled in the art at the time of the invention to employ compositions selected

from those disclosed by Mikune et al comprising cyanoacrylate monomers for the uses discussed by

Coover et al.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hiraiwa et al (4,818,325)disclose a method of bonding employing a primer comprising an

organometallic compound and a cyanoacrylate adhesive. Thickener is used to increase viscosity since the

2-cyanoacrylate is a low viscous liquid having a viscosity of about several cp (column 8, lines 15-20).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Berman whose telephone number is (703) 308-0040.

The fax number for this group is (703) 872-9310 or, for submissions after Final Rejection. (703) 872-9311.

Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist at telephone number (703) 308-0661.

Susan Berman Primary Examiner

Lusar Berman

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